

REMARKS

Claims 11 – 14, 19 – 23, 27 – 29, and 55 – 63 remain in the present application. Claims 1 – 10, 15 – 18, 21, 24 – 26, 30 – 54, and 64 are cancelled.

The Examiner states that the interference of claims 55 – 63 has not been initiated as claims 55 – 63 are not patentable. It is respectfully submitted that these claims are patentable for at least the reasons set forth below, whereby an interference should now be initiated.

Claims 11 – 13, 16 – 18, 23, 25, 27, 55 – 57, 60, and 63 stand rejected as being allegedly unpatentable over Yamamoto et al. Claims 16 – 18 and 25 were cancelled in the previous Amendment.

Claim 11 recites, in part, “an elastomeric member threaded through the dimples”. The Examiner acknowledges, “Yamamoto does not expressly disclose threading the elastomeric member through the dimples.” The Examiner then states:

However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to thread the elastomeric member through the dimples, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japikse, 86 USPQ 70.

More specifically, MPEP 2144.04 VI.C. states:

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contract in a conductivity measuring device was held to be an obvious matter of design choice). However, “The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device.” *Ex parte Chicago Rawhide Mfg. Co.*, 233 USPQ 351, 352 (Bd. Pat. App. & Inter. 1984).

Accordingly, *In re Japinkse*, holds that the “shifting the position of the starting switch would not have ***modified the operation of the device***” (emphasis added), and therefore, was an unpatentable variation. This is clearly not the case in the present invention as recited by claim 11. More specifically, the electrically conductive planar member has the surfaces thereof exposed to facilitate electrical communication. Yamamoto et al. never exposes the surfaces of the metal sheet 1, see figures 1 – 4 and 7 thereof. Further, see column 3, lines 34 – 37 of Yamamoto et al., where it states that, “the sheet gasket [is] prepared by laminating the above-mentioned blend on both sides of the various thin metal sheets”. This facilitation of electrical communication is why the recited pressure pad of claim 11 is for an electrochemical cell, where the facilitation of electrical communication is achieved by threading the elastomeric member thereby leaving the surfaces exposed.

Further, *Ex parte Chicago Rawhide Mfg. Co.* USPQ 351 (Bd. Pat. App. & Inter. 1984), cited in MPEP 2144.04 VI.C., holds that “the prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant’s specification, to make the necessary changes in the reference device”. The Examiner has not identified any suggestion whatsoever to make the changes that the Examiner has suggested. Applicants submit that there is no motivation in the prior art, because the cited gasket does not seek to address the same problems that are found in an electrochemical cell.

For at least the foregoing reasons, claim 11 and claims 12 and 13, which are dependent therefrom, patentably define over Yamamoto et al.

Claim 23 recites, in part, “an elastomeric member threaded transversely through raised portions in the corrugated member”. The Examiner states “with respect to claim 23, the electrically conductive member (2) is corrugated; and elastomeric member (1) is disposed at the corrugated member. See Figure 4.” The Examiner has not addressed the limitation of “an elastomeric member ***threaded transversely through raised portions in the corrugated member***”, emphasis added. This limitation clearly patentably defines over Yamamoto et al. If the Examiner intended to raise the issues as discussed above

with respect to claim 11, then the Examiner is respectfully referred to the above discussion, as it is equally applicable to claim 23.

For at least the foregoing reasons, claim 23 and claim 27, which is dependent therefrom, patentably define over Yamamoto et al.

Claim 55 recites, in part, “elastomeric material mounted within said channels, said elastomeric material being dimensioned so that, when said elastomeric material is compressed, said elastomeric material lies flush with said ribs and exerts substantially uniform pressure across each of said top surface and said bottom surface of said single sheet”. The Examiner states that “the elastomeric material being compressed to lie flush with the ribs and exert substantially uniform pressure across each of the top and bottom surfaces, is considered an inherent property of the gasket taught by Yamamoto”, with reference to figure 2 of Yamamoto et al. This is simply not true. Applicants fail to appreciate how “the elastomeric material being compressed to lie flush with the ribs” is in any way whatsoever possible in the gasket taught by Yamamoto et al. When the gasket of figure 2 of Yamamoto et al. is compressed, the material designated 2 will always lie above every surface of the material designated 1. Claim 55 requires that “when said elastomeric material is compressed, said elastomeric material lies flush with said ribs”. In order for the elastomeric material to lie flush with the ribs it cannot extend above the ribs (when compressed), and most certainly cannot lie over or on top of the ribs. The single sheet of electrically-conductive material recited in claim 55 has the surfaces thereof exposed to facilitate electrical communication. Yamamoto et al. never exposes the surfaces of the metal sheet 1, see figures 1 – 4 and 7 thereof. Further, see column 3, lines 34 – 37 of Yamamoto et al., where it states that, “the sheet gasket [is] prepared by laminating the above-mentioned blend on both sides of the various thin metal sheets”. This facilitation of electrical communication is why the recited pressure pad of claim 11 is for an electrochemical cell, where the facilitation of electrical communication is achieved by threading the elastomeric member thereby leaving the surfaces exposed.

For at least the foregoing reasons, claim 55 and claims 56, 57, 60, and 63, which are dependent therefrom, patentably define over Yamamoto et al.

Therefore, reconsideration and allowance of claims 11 – 13, 23, 27, 55 – 57, 60, and 63 stand rejected as being allegedly unpatentable over Yamamoto et al.

Claims 11 – 13, 16, 20, and 22 stand rejected as being allegedly unpatentable over Wakamatsu. Claim 16 was cancelled in the previous Amendment.

Claim 11 recites, in part, “an elastomeric member threaded through the dimples”. The Examiner has not addressed the limitation of “an elastomeric member *threaded through the dimples*”, emphasis added. This limitation clearly patentably defines over Wakamatsu. If the Examiner intended to raise the issues as discussed above with respect to Yamamoto et al., then the applicants have responded accordingly below.

The electrically conductive planar member of claim 11 has the surfaces thereof exposed to facilitate electrical communication. Wakamatsu never exposes the surfaces of the gasket body 2, see any of the figures (including figure 2) thereof. Further, see column 3, lines 62 – 66 of Wakamatsu, where it states that, “the gasket body 2 is covered with a sealing bead or sealant 6 composed of an elastic material, which form an upper sealing section 7 on the upper surface, a lower sealing section 8 on the lower surface, and an inner sealing section 9 on the inner face of each opening”. This facilitation of electrical communication is why the recited pressure pad of claim 11 is for an electrochemical cell, where the facilitation of electrical communication is achieved by threading the elastomeric member thereby leaving the surfaces exposed.

For at least the foregoing reasons, claim 11 and claims 12, 13, 20, and 22 which are dependent therefrom, patentably define over Wakamatsu. Therefore, reconsideration and allowance of claims 11 and claims 12, 13, 20, and 22 are respectfully requested.

Claims 19, 29, and 61 stand rejected as being allegedly unpatentable over Yamamoto et al. in view of Leonida et al. Claim 19 depends from claim 11, which should now be allowable for at least the reasons set forth above. Claim 29 depends from claim 23, which should now be allowable for at least the reasons set forth above. Claim 61 depends from claim 55, which should now be allowable for at least the reasons set forth above. Accordingly, claims 19, 29, and 61 should now be allowable as depending

from what should now be allowable independent claims. Therefore, reconsideration and allowance of claims 19, 29, and 61 are respectfully requested.

Claims 20, 28, 58, and 59 stand rejected as being allegedly unpatentable over Yamamoto et al. in view of Furuse et al. Claim 20 depends from claim 11, which should now be allowable for at least the reasons set forth above. Claim 28 depends from claim 23, which should now be allowable for at least the reasons set forth above. Claims 58 and 59 depend from claim 55, which should now be allowable for at least the reasons set forth above. Accordingly, claims 20, 28, 58, and 59 should now be allowable as depending from what should now be allowable independent claims. Therefore, reconsideration and allowance of claims 20, 28, 58, and 59 are respectfully requested.

Claim 14 stands rejected as being allegedly unpatentable over Yamamoto et al. in view of Kuriyama et al. Claim 14 depends from claim 11, which should now be allowable for at least the reasons set forth above. Accordingly, claim 14 should now be allowable as depending from what should now be allowable independent claims. Therefore, reconsideration and allowance of claim 14 are respectfully requested.

Claim 62 stands rejected as being allegedly unpatentable over Yamamoto et al.. Claim 62 depends from claim 55, which should now be allowable for at least the reasons set forth above. Accordingly, 62 should now be allowable as depending from what should now be allowable independent claims. Therefore, reconsideration and allowance of claim 62 are respectfully requested.

Accordingly, as the cited references in the Office Action neither anticipate nor render obvious that which the applicant deems to be the invention, it is respectfully requested that claims 11 – 14, 19 – 23, 27 – 29, and 55 – 63 be passed to issue.

It is believed that the foregoing remarks fully comply with the Office Action.
If there are any additional charges with respect to this Amendment or otherwise, please
charge them to Deposit Account No. 06-1130 maintained by Applicants' attorney.

Respectfully submitted,

MOLTER ET AL.

CANTOR COLBURN LLP

By: 

Philmore H. Colburn II

Registration No. 35,101

Customer Service No. 23462

Cantor Colburn LLP

55 Griffin Road South

Bloomfield, CT 06002

Telephone: (860) 286-2929

Date: November 7, 2006